

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/785,969

Filing Date: February 17, 2001

Title: METHOD AND APPARATUS FOR ACCESSING AND STORING DIGITAL IMAGES

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**Remarks**

Claims 1-4, 7-27, 29-34 and 36 are pending. Claims 5, 28, 35 and 37 are canceled in this Response.

1. Claims 1-3, 7-10, 13-16, 18, 24-28, and 33-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski (U.S. 6,836,617) in view of Bidun (WO 2001-63518) and further in view of Miyamoto (U.S. 6,456,391).

**Claims 1, 13 and 15 as amended**

Claim 1 has been amended to recite displaying a price for storing the at least one digital image at the remote site, prompting a customer for payment of the price, receiving a payment for storing the at least one digital image at the remote site, storing the at least one digital image at the remote site, and printing a sales receipt that includes the price paid for storing the at least one digital image at the remote site, the date the payment was received, and a thumbnail of the at least one digital image stored at the remote site. Support for the amendments may be found in the Specification at paragraphs [0019]-[0021].

Miyamoto's index print of thumbnail images is not a sales receipt. Claim 1 has been amended to expressly recite two characteristics inherent in a *sales* receipt -- the price paid and the date of payment. The index print in Miyamoto does not include the price paid for storing the images or the date payment was received for storing the images. Hence, Miyamoto does not teach or suggest the sales receipt of amended Claim 1. The combination of Parulski, Bidun and Miyamoto also do not teach or suggest the combination of elements now recited in amended Claim 1 -- displaying a price for storing an image, prompting a customer to pay the price, receiving payment and then printing a sales receipt.

Similar amendments have been made to Claims 13 and 15.

Claims 1, 13 and 15 as amended along with their respective dependent claims distinguish patentably over the cited references and the rejection of those claims should be withdrawn.

**Claim 19**

Claim 19 recites a card reader and a processor responsive to the card reader programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site. In support of the rejection of Claims 19-21, the Examiner states

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only that "Claims 19-21 are rejected for the same reasons set forth for the method claim above." The Examiner's apparent reference to the method of Claim 1 is misplaced because Claim 19 contains limitations not found in Claim 1. In fact, so far as Applicants can tell, neither Parulski, Bidun nor Miyamoto teach or suggest sending digital images from a user's digital camera to a remote storage site. Bidun actually seems to teach away from the invention as recited in Claim 19, as it touts the advantages of being free of a camera and other equipment related to the camera.

If the Examiner disagrees, he is respectfully requested to specifically point out and explain those passages in any or all of the cited references that teach the limitations recited in Claims 19-21. Absent such a showing, the rejections should be withdrawn.

Claim 24

Claim 24 recites a program for instructing a processor to receive digital images via the interface, determine a price for storing the digital images at a remote site, process payment information and send paid-for digital images to the remote site. The Examiner does not specifically address the limitations of Claim 24 in the pending Office Action. The Examiner makes some vague assertions at pages 6-7 of the Action about a computer program to "determine a price for storing the digital images at a remote site, process payment information, and send paid-for digital images to the remote site...." These assertions are not supported by citation to any reference. Furthermore, the Examiner's discussion of method Claim 1 does not address the pricing and payment limitations in Claim 24. The Examiner has, therefore, failed to establish a prima facie case of obviousness as to Claim 24 and 25-32 depending from Claim 24.

2. Claims 4, 17, 22, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Bidun and further in view of www.telepix.com. The Examiner asserts that www.telepix.com teaches printing a receipt. Claims 4-5, 17 and 22-23 are all dependent claims. It is not clear if the Examiner intends the combination of Parulski, Bidun and telepix as an independent grounds for rejecting the base claims too, or if the Examiner mistakenly failed to also cite to Miyamoto, as in the rejection of the base claims. In any event, the only discussion of a receipt in telepix appears to be on page 3 of the reference, marked 2X. There is no further discussion of printing a receipt or a discussion detailing the form of the

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receipt in the www.telepix.com reference (2X). In fact, there is some question as to whether the receipt is a sales receipt. Claim 4 depends from amended Claim 1 which recites "printing a sales receipt including the price paid for storing the at least one digital image at the remote site, the date the payment was received and a thumbnail of the at least one digital image stored at the remote site." There is no mention of this complete element in telepix.

Claim 17 depends from Claim 15. Claim 17 includes the elements of amended Claim 15 which recites "means for printing a sales receipt including the price paid for storing the digital images at the remote site, the date the payment was received and information identifying the stored images." Again, there is no mention of this complete element in telepix.

Claim 22 depends from Claim 19. Claim 22 includes the elements of Claim 19 which recites

...a processor responsive to the card reader and programmed to perform a point-of-sale financial transaction for sending digital images from a user's digital camera to a remote storage site, the processor confirming storage of digital images at the remote storage site in response to confirmation sent from the remote storage site...

Claim 22 also adds "...a receipt printer coupled to the processor; whereby the processor can command the printer to print out receipts of the transactions." Claim 23 depends from Claim 22 and adds that the processor commands the printer to print receipts including thumbnails of paid for images. The complete recitations included in Claim 22 (and Claim 19) are not taught in the references. Accordingly, since the combination of references falls short of the claim language, the claims overcome the Examiner's rejection under 35 USC § 103(a).

3. Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Parulski in view of Bidun as applied to Claims 1 and 11 and further in view of Eastman Kodak ("Kodak to acquire 51% stake in Picture Vision", M2 Presswire, February 13, 1998, pg. 1). It is not clear if the Examiner intends the combination of Parulski, Bidun and Kodak as an independent grounds for rejecting the base claims too, or if the Examiner mistakenly failed to also cite to Miyamoto, as in the rejection of the base claims. Claim 12 depends indirectly from Claim 1, which recites "printing a sales receipt including the price paid for storing the at least one digital image at the remote site, the date the payment was received and a thumbnail of the at

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least one digital image stored at the remote site." The Examiner admits that neither the Parulski reference or Bidun reference teaches printing a receipt. Kodak also does not teach printing a receipt as claimed and the Examiner makes no specific assertion to the contrary. As a result, the Examiner has failed to make out a prima facie case of obviousness and the rejection of Claim 12 should be withdrawn.

The foregoing is believed to be a complete response to the pending office action.

Respectfully submitted,

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By \_\_\_\_\_

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